

## **REMARKS**

Claims 59-61 have been amended. Claims 1-61 remain pending in the application.

### **Objection to the Drawings:**

The Examiner states that FIGs. 1-2 should be designated by a legend such as --Prior Art--. A replacement sheet is included herewith in which a --Prior Art-- designation has been added for FIGs. 1A & 1B. No change has been made for FIG. 2 since FIG. 2 does not illustrate only that which is known from the prior art. Withdrawal of the objection to the drawings is respectfully requested.

### **Section 101 Rejection:**

The Examiner rejected claims 59-61 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicants assert that an “article of manufacture” is statutory subject matter. In fact, 35 U.S.C. § 101 specifically refers to a “manufacture” as patentable subject matter. There is no basis in the statute, case law or MPEP to support the Examiner’s assertion that reciting an “article of manufacture” in a claim means that the claim is nonstatutory. Accordingly, the rejection is traversed. For reasons of expediency, claims 59-61 have been amended to recite a “tangible, computer-readable medium” instead of an “article of manufacture”; however, Applicants do not view this as a change in the scope of the claim or as an amendment made for a reason of patentability. Withdrawal of the § 101 rejection is respectfully requested.

### **Provisional Double Patenting Rejection:**

The Examiner *provisionally* rejected claims 1-61 under the judiciary created doctrine of obviousness-type double patenting as being unpatentable over claims 1-40, 1-203 and 1-71 of co-pending Application Nos. 10/055,645, 10/055,641 and 10/055,741

respectively. Applicants traverse this rejection on the grounds that the Examiner has not stated a proper *prima facie* rejection. The only support given by the Examiner for the rejection is “because the context of the claimed invention is the same as the context of the cited claims of the U.S. patent applications.” However, simply being in the same context (whatever that means) is not a proper reason for holding the claims of the present application obvious from the claims of the listed applications. According to MPEP 804.II.B.1, “the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection.” This section of the MPEP also states that the same “factual inquiries ... that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are employed when making an obviousness-type double patenting analysis.” MPEP 804.II.B.1 also states that the Examiner should list the differences between each rejected claim and the claims of the other patent/application, and for each difference the Examiner should give the reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim is an obvious variation of the invention defined in a claim of the other patent/application. Simply stating that the claims are “in the same context” is not a valid reason why a person of ordinary skill in the art would conclude that the invention defined in each claim is an obvious variation of the invention defined in a claim of the other patent/application. Nor has the Examiner specifically addressed **each difference** of **each claim** of the present application compared to the claims of the other applications. Instead, the Examiner improperly lumped all the claims together and did not address each specific difference. The Examiner clearly has not met the requirements stated in MPEP 804.II.B.1 to establish a *prima facie* obviousness-type double patenting rejection. Accordingly, Applicants respectfully request removal of the double patenting rejection of claims 1-71.

Furthermore, according to M.P.E.P. 804.I.B and 822.01: “If the ‘provisional’ double patenting rejections in both applications are the only rejections remaining in those applications, the Examiner should then withdraw that rejection in one of the applications and permit the application to issue as a patent. The examiner should maintain the double patenting rejection in other application as a ‘provisional’ double patenting rejection

which will be converted into a double patenting rejection when the other application issues as a patent.” Since the provisional double patenting rejection is the only rejection remaining in the present application (as well as the 10/055,741 application), the Examiner must withdraw the provisional double patenting rejection in one of those applications and allow that application to issue as a patent. If the Examiner still believes such a rejection appropriate, the Examiner should make a proper *prima facie* rejection in the other application(s).

## CONCLUSION

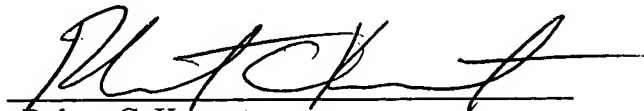
Applicants submit the application is in condition for allowance, and notice to that effect is respectfully requested.

If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above-referenced application from becoming abandoned, Applicant(s) hereby petition for such an extension. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5681-07300/RCK.

Also enclosed herewith are the following items:

- ☒ Return Receipt Postcard
- ☐ Petition for Extension of Time
- ☐ Notice of Change of Address
- ☒ Replacement Drawing Sheet

Respectfully submitted,



Robert C. Kowert  
Reg. No. 39,255  
ATTORNEY FOR APPLICANT(S)

Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C.  
P.O. Box 398  
Austin, TX 78767-0398  
Phone: (512) 853-8850

Date: October 11, 2005

**In the Drawings:**

Please amend FIGs. 1A & 1B to included a --Prior Art-- designation as shown in the replacement sheet included herewith.